



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/990,670 | 11/16/2001 | Thomas Hicks | 6414-61471 | 2776 |

7590 02/16/2005

Marger Johnson & McCollom, P.C.
1030 S.W. Morrison Street
Portland, OR 97205

| |
|----------|
| EXAMINER |
|----------|

TSOY, ELENA

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1762

DATE MAILED: 02/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,670

Applicant(s)

HICKS, THOMAS

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 and 19-50 is/are pending in the application.
- 4a) Of the above claim(s) 38,39 and 42-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6,19-37,40-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 14, 2005 has been entered.

Response to Amendment

2. Amendment filed on February 10, 2005 has been entered. Claims 1-3, and 7-18 have been cancelled. New claims 32-50 have been added. Claims 4-6, 19-50 are pending in the application.

Election/Restrictions

3. Newly submitted claims 38-39, 42-50 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the inventions of claims 38-39, 42-50 are distinct because the product as claimed can be made by another and materially different process (MPEP § 806.05(f)) such as a process comprising half-tone printing.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38-39, 42-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Declaration under 37 CFR 1.132

Art Unit: 1762

4. The Declaration under 37 CFR 1.132 filed February 10, 2005 is insufficient to overcome the rejection of claims 4-6, 19-35 based upon Charley et al as set forth in the last Office action because: Mirror-image printing is a preferred method of Charley et al. However, at column 2, lines 47-60, Charley et al teach printing without the use of a layer of opaque white. It is held that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123. Therefore, *non-preferred* method of Charley et al **without** the use of a layer of opaque white is as relevant as a preferred method with the use of a layer of opaque white.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Oberwager (US 3,815,263).

Oberwager discloses a method of simulating a stained glass window (See column 1, lines 3-6) comprising placing against a window a flexible composite sheet (claimed flexible sheet of plastic material) comprising a clear front layer of plastic on which there are printed an opaque lead pattern, a shading pattern over desired areas and dotted guide lines having printed shading pattern thereon (See column 2, lines 6-15), a layer of assembled rectangular sheets of translucent plastic of different colors placed on the rear face of the front layer, and a clear backing layer of

Art Unit: 1762

plastic material placed over the assembled colored patterns (See column 2, lines 16-35). The individual sheets are preferably made of highly plasticized vinyl material. If the colored middle sheet is highly plasticized, the composite sheet adheres together without the need for any adhesives. Moreover, if the rear sheet is also plasticized in this manner, the finished product can be placed against a window and it will remain there for many years without falling off. See column 2, lines 36-46. In this case, light which shines through the window and the finished simulated stained-glass window provides the most realistic effect yet produced. When viewed from the front, what is seen is the lead pattern which separates individual sections of what appear to be stained glass. See column 2, lines 28-35.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 4, 32, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413) for the reasons of record as set forth in Paragraph No. 2 of the Office Action mailed on January 27, 2004. The added limitation of claim 4 “allowing light to pass all the way through the window covering” and limitations of claims 32 and 34 would not change the scope of the claim because a window covering of Cliffe would be substantially identical to that of claimed invention and, therefore, would have the same properties as window covering of claimed invention.

Art Unit: 1762

9. **Claims 4, 5, 19-21, 32, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on January 27, 2004. The added limitation of claim 4 “allowing light to pass all the way through the window covering” and limitations of claims 32 and 34 would not change the scope of the claim because a window covering of Cliffe would be substantially identical to that of claimed invention and, therefore, would have the same properties as window covering of claimed invention.

10. **Claims 4, 22, 32, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Pohn (US 4,791,745) for the reasons of record as set forth in Paragraph No. 6 of the Office Action mailed on August 16, 2004. The added limitation of claim 4 “allowing light to pass all the way through the window covering” and limitations of claims 32 and 34 would not change the scope of the claim because a window covering of Cliffe would be substantially identical to that of claimed invention and, therefore, would have the same properties as window covering of claimed invention.

11. **Claims 4, 5, 19-22, 32, 34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date) for the reasons of record as set forth in Paragraph No. 7 of the Office Action mailed on August 16, 2004. The added limitation of claim 4 “allowing light to pass all the way through the window covering” and limitations of claims 32 and 34

Art Unit: 1762

would not change the scope of the claim because a window covering of Cliffe would be substantially identical to that of claimed invention and, therefore, would have the same properties as window covering of claimed invention.

12. **Claims 6, 23, 26, 27, 29, 31, 33, 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Cooledge et al (US 5,258,214) for the reasons of record as set forth in Paragraph No. 8 of the Office Action mailed on August 16, 2004. The added limitation of claim 6 “allowing light to pass all the way through the window covering” and limitations of claims 33 and 35 would not change the scope of the claim because a window covering of Cliffe would be substantially identical to that of claimed invention and, therefore, would have the same properties as window covering of claimed invention.

13. **Claim 24** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Collier (US 4,684,675) for the reasons of record as set forth in Paragraph No. 9 of the Office Action mailed on August 16, 2004.

14. **Claim 25** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413) (or in view of Pohn (US 4,791,745)), further in view of Chmielnik (US 5,617,790) for the reasons of record as set forth in Paragraph No. 10 of the Office Action mailed on August 16, 2004.

Art Unit: 1762

15. **Claim 25** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) (or in view of Pohn (US 4,791,745)) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Chmielnik (US 5,617,790) for the reasons of record as set forth in Paragraph No. 11 of the Office Action mailed on August 16, 2004.

16. **Claim 28** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, further in view of Cooledge et al (US 5,258,214), and further in view of Collier (US 4,684,675) for the reasons of record as set forth in Paragraph No. 12 of the Office Action mailed on August 16, 2004.

17. **Claim 30** stands rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, further in view of Cooledge et al (US 5,258,214), and further in view of Chmielnik (US 5,617,790) for the reasons of record as set forth in Paragraph No. 13 of the Office Action mailed on August 16, 2004.

17. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cliffe (US 4,528,232) in view of Taylor et al (US 5,672,413) or Charley et al (US 6,030,002) in view of Taylor et al (US 5,672,413) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior

Art Unit: 1762

art with no date) or Cliffe (US 4,528,232) in view of Pohn (US 4,791,745) or Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, and further in view of advertisement for Solar Stat (admitted prior art with no date), and further in view of Oberwager (US 3,815,263).

Prior art of record is applied here for the same reasons as set forth in the Office Action mailed on January 27, 2004 and in the Office Action mailed on August 16, 2004. The Prior art of record fails to teach that the window covering simulates a stained glass window.

Oberwager teaches that cling window covering can be made to simulate a stained glass window using assembled tiles of translucent plastic of different colors.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a window covering of the prior art of record et al from assembled plastic tiles, each of which is printed with translucent inks of different colors and opaque lead lines with the expectation of providing the desired simulated stained glass window, as taught by Oberwager.

18. **Claim 36** is rejected under 35 U.S.C. 103(a) as being unpatentable over Charley et al (US 6,030,002) in view of Pohn (US 4,791,745) and Cliffe (US 4,528,232), further in view of Rega et al (US 6,054,208) and GB 2324381, further in view of advertisement for Solar Stat, and further in view of Cooledge et al (US 5,258,214), and further in view of Oberwager (US 3,815,263).

Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of advertisement for Solar Stat in view of Cooledge et al are applied here for the same reasons as set forth in Paragraph No. 8 of the Office Action mailed on August 16, 2004. Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of advertisement for

Art Unit: 1762

Solar Stat in view of Cooledge et al fail to teach that the window covering simulates a stained glass window.

Oberwager teaches that cling window covering can be made to simulate a stained glass window using assembled tiles of translucent plastic of different colors.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made a window covering of Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of advertisement for Solar Stat in view of Cooledge et al from assembled plastic tiles, each of which is printed with translucent inks of different colors and opaque lead lines with the expectation of providing the desired simulated stained glass window, as taught by Oberwager.

Response to Arguments

19. Applicants' arguments filed February 10, 2005 have been fully considered but they are not persuasive.

(A) Applicants argue that Charley et al utilize a layer of opaque white imprinting film and thus the film and printed translucent colored image would not allow light to pass.

The Examiner respectfully disagrees with this argument. Mirror-image printing is a preferred method of Charley et al. However, at column 2, lines 47-60, Charley et al teach printing without the use of a layer of opaque white.

It is held that PATENTS ARE RELEVANT AS PRIOR ART FOR ALL THEY CONTAIN. See *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998) (The court held that the prior art anticipated

Art Unit: 1762

the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). NONPREFERRED EMBODIMENTS CONSTITUTE PRIOR ART. Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. See MPEP 2123.

Therefore, *non-preferred* method of Charley et al **without** the use of a layer of opaque white is as relevant as a preferred method with the use of a layer of opaque white.

(B) Applicants argue that it is not obvious to apply a layer of translucent varnish *before* applying a layer of ink.

However, claimed invention also applied a layer of translucent varnish *after* applying a layer of ink (See claims 5, 20, 21).

If Applicants' argument applies to claim 24, it was discussed in Paragraph No. 9 of the Final Rejection of August 16, 2004, that although Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat fail to teach that matte varnish is applied before applying a color image, Collier teaches that applying first a matte lacquer (varnish) to PVC film of 2-8 mils thickness (See column 3, lines 15-19) before applying a color image provides the PVC film with desired non-streaking properties (See Abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied first a matte lacquer (varnish) to PVC film of Charley et al in view of Pohn and Cliffe in view of Rega et al and GB 2324381 in view of Solar Stat before applying a color image with the expectation of providing the PVC film with desired non-streaking properties, as taught by Collier.

Art Unit: 1762

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELENA TSOY
PRIMARY EXAMINER
ETsoy

Elena Tsoy
Primary Examiner
Art Unit 1762

February 15, 2005